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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,493	07/02/2003	Daniel David Lecloux	UC0213 US NA2	3538

23906 7590 01/10/2005

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EXAMINER
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AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/612,493

Applicant(s)

LECLOUX ET AL.

Examiner

Charanjit S. Aulakh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-39 is/are pending in the application.
- 4a) Of the above claim(s) 6-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. According to paper filed on Nov. 10, 2004, the applicants have canceled claim 4; withdrawn claims 6-39 and furthermore, have amended claims 1 and 5.
2. Claims 1-3 and 5-39 are now pending in the application. Claims 6-39 are withdrawn as being directed to non-elected subject matter.

### ***Response to Arguments***

3. Applicant's arguments filed on Nov. 10, 2004 have been fully considered but they are not persuasive regarding prior art rejections. The applicants have amended claims to overcome indefiniteness rejections. It is of note that election was without traverse and therefore, applicants need to cancel withdrawn claims 6-39 directed to non-elected subject matter. In regard to prior art rejections over all three cited references, the examiner does not agree with the applicants arguments that instant claims 1-3 are not anticipated by the cited references.

In regard to Nakada's reference ( EP 0 564 224 ), compounds 26 ( see page 11 ), 29 and 32 ( see page 12 ) and compounds 40-43 ( see pages 14-15 ) do anticipate the instant claims when both x and y are 0, only x is 0, x is 2 and x is 1 and R1 represents phenyl substituted with C<sub>n</sub>HaF<sub>b</sub> and n is 1 ( when a+b=3, it can represent CH<sub>3</sub> group ) in the instant compounds of formula (I).

In regard to Dietrich-Buchecker's reference, compounds 2a, 3a, 3b, 4a and 4b do anticipate the instant claims when x is 1 or 2 and R1 represents phenyl substituted with OcnHaF<sub>b</sub> and n is 1 ( when a+b=3, it represents OCH<sub>3</sub> group ) in the instant compounds of formula (I).

Art Unit: 1625

In regard to Daniel's reference, the compounds II, IV ( see col. 7 ), compound VIII ( see col. 9 ), compound X ( see col. 11 and compound XXI ( see col. 17 ) do anticipate the instant claims when X is 1 or 2 and R1 represents phenyl substituted with either  $OcnHaFb$  or  $CnHaFb$  and n is 1 ( when  $a+b=3$ , it can represent  $OCH_3$  or  $CH_3$  group ) in the instant compounds of formula (I).

NEW GROUNDS OF REJECTION

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2 recites the limitation "composition" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "composition" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation " x is 1 and both R1 are  $C_6H_4F$  ( compound II e )" in claim 1. There is insufficient antecedent basis for this limitation in the claim since this combination is eliminated by the proviso.

***Conclusion***

6. Prior art rejections of claims 1-3 under 35 U.S.C. 102(b) over all three cited references are maintained for the reasons of record.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charanjit S. Aulakh  
Primary Examiner  
Art Unit 1625